



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,265	06/07/2001	Masahiko Matsuura	44318-045	4618

20277 7590 03/19/2003
MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

BEATTY, ROBERT B

ART UNIT	PAPER NUMBER
----------	--------------

2852

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,265

Applicant(s)

MATSUURA ET AL.

Examiner

Robert Beatty

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 26-29 is/are rejected.
- 7) ☒ Claim(s) 22-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 11-13, 20-21, 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Umeda (JP# 06-67141).

Umeda teach an image forming apparatus (see Fig.4) comprising a photoconductor 2, a latent image forming device 4, a developing device 28, a transfer roller 7 connected to a bias supply 30, and a fixing device 31. The apparatus also has a first supply tray 25 having a first recording medium 27, and a second supply tray 26 having a re-writable recording medium 1. In operation, if a first supply tray is chosen, the latent image information on the photoconductor will be developed with toner and transferred to the recording medium 27; if a second supply tray is chosen, the developing device will be retracted (image forming element) and the transfer roller (image forming element) grounded such that an image is displayed on this second recording medium via the charged latent image information on the photoconductor.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10,14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umeda (JP 06-67141) in view of Takano et al.

Umeda taught supra discloses most of what is claimed except a medium type detecting device which detects whether the recording medium is a normal or reversible display medium and controlling the image forming apparatus accordingly. Takano et al. teach an image forming apparatus wherein a medium cassette 1 has a data indicating means 12 which indicates the attributes of the recording medium within the medium cassette and a reading means 22 for reading out the data. According to the detected information, the image forming apparatus will be controlled accordingly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a recording medium data indicating means and reader for the data indicating means and for controlling the image forming apparatus accordingly the images can be formed under the proper conditions as taught in Takano et al.

3. Claims 22-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


4. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues that Umeda cannot distinguish an inadvertent mix in the medium cassette of normal and reversible mediums. However, it is to be noted that applicant's claim is not so limiting as to distinguish individual sheets within the cassette. As a matter of fact, the applicant has many embodiments where the medium indicating means is on the cassette (which would obviously apply to all the mediums within the cassette whether they are mixed or not). See for example applicants Fig. 26A and 26B. Additionally, applicant argues that Umeda does not teach the "standard mode" which the claim calls for. However, in these claims applicant states that either recording medium (reversible or normal) can be called the "standard" mode and the other the non-standard mode therefore the importance is not deemed to be a critical feature on which patentability can rest. Finally, applicant argues that Ito does not teach the recording medium detecting means that applicant describes in the specification. Therefore, the examiner has applied a reference (Takano et al.) which is similar to applicant's cassette detecting scheme in Figs 26A and 26B.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is 703-308-1372. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3431.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A handwritten signature in black ink, appearing to read 'Robert Beatty', with a stylized, flowing script.

Robert Beatty
Primary Examiner
Art Unit 2852

March 17, 2003